

Attorney's Docket No.: 10559/329001/P9832
Serial No.: 09/676,319

REMARKS

Claims 1-41 are pending in the application. The Abstract is objected to. Claims 4 and 38-41 stand rejected under 35 U.S.C. 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-5, 13-17, 25-27, and 38-41 stand rejected under 35 U.S.C. 102(e) as allegedly being anticipated by U.S. Patent No. 6,321,339 to French et al. ("French"). Claims 6-8, 10-11, 18-19, and 28-32 stand rejected under 35 U.S.C. 102(b) as allegedly being anticipated by Menezes et al. "Handbook of Applied Cryptography" ("Menezes"). Claim 18 stands rejected under 35 U.S.C. 102(b) as allegedly being anticipated by Aberdeen Group "Evaluating the Cost of Ownership for Digital Certificate Projects" ("Aberdeen"). Claims 28-32 stand rejected for the same alleged reasons as provided for claims 6-10 and further because it is alleged that it is inherent that computer program instructions were provided for the authentication of Menezes to function properly in a computer environment.

In view of the amendments and remarks herein, the rejections are respectfully traversed. Reconsideration and allowance are respectfully requested.

I. The Objection to the Abstract

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The Abstract has been amended to delete the heading and to delete the objected-to language.

II. The Rejections under 35 U.S.C. 112

Claim 4 has been amended to correct the antecedent basis, rendering the rejection moot.

Claim 38-40 have been amended to remove the references to substantially dynamic and substantially static information.

Claim 40 still includes the feature that information is updated "on a substantially regular basis." The rejection of claim 40 based on this feature is respectfully traversed.

According to the Federal Circuit, when the term substantially "serves reasonably to describe the subject matter so that its scope would be understood by persons in the field of the invention, and to distinguish the claimed subject matter from the prior art, it is not indefinite." *Verve LLC v. Crane Cams, Inc.*, 311 F.3d 1116, 1119 (Fed. Cir. 2002).

The Federal Circuit explained:

Expressions such as "substantially" are used in patent documents when warranted by the nature of the invention, in order to accommodate the minor variations that may be appropriate to secure the invention. Such usage may well satisfy the charge to "particularly point out and distinctly claim" the invention, 35 U.S.C. § 112, and indeed may be necessary in order to provide the inventor with the benefit of his invention. In *Andrew Corp. v. Gabriel Elecs. Inc.*, 847 F.2d 819, 821-22, 6 USPQ2d 2010, 2013 (Fed.Cir.1988) the court explained that usages such as "substantially equal" and "closely

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approximate" may serve to describe the invention with precision appropriate to the technology and without intruding on the prior art. The court again explained in *Ecolab Inc. v. Envirochem, Inc.*, 264 F.3d 1358, 1367, 60 USPQ2d 1173, 1179 (Fed.Cir.2001) that "like the term 'about,' the term 'substantially' is a descriptive term commonly used in patent claims to 'avoid a strict numerical boundary to the specified parameter,' " quoting *Pall Corp. v. Micron Separations, Inc.*, 66 F.3d 1211, 1217, 36 USPQ2d 1225, 1229 (Fed.Cir.1995). It is well established that when the term "substantially" serves reasonably to describe the subject matter so that its scope would be understood by persons in the field of the invention, and to distinguish the claimed subject matter from the prior art, it is not indefinite. *Verve LLC v. Crane Cams, Inc.*, 311 F.3d 1116, 1119 (Fed. Cir. 2002).

With respect to claim 40, a person of ordinary skill in the art would understand that a "substantially regular basis" need not be precisely regular. For example, daily updating may be performed at some point during each day, but need not be performed at exactly the same time each day.

Claim 40 is therefore definite, and it is respectfully requested that the rejection under 35 U.S.C. 112 be withdrawn.

III. The Rejections Under 35 U.S.C. 102 and 103

The claims have been amended to more clearly emphasize patentable combinations.

Claim 1

For example, claim 1 has been amended to recite that "the registration information includes information indicative of an identity of the user, and further includes a registration status

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of the user indicating whether the user is currently in compliance with one or more requirements of a professional registration authority."

In contrast, the registration information identified by the office action is indicative of identity only. The office action identifies elements 16, 18, and 20 of FIG. 1 of French as teaching registration information. According to column 12, lines 54-64, the information is "wallet-type information":

FIG. 1 is a flowchart illustrating the overall authentication process according to the invention. Authentication process 10 starts at step 12. The authentication process 10 prompts a user for first level information at step 14. Again, the first type of information is preferably wallet-type information, that is, information such as name, address, driver's license or other information commonly carried on the person. The user inputs that first level information via a keyboard, mouse, voice digitizer or other suitable input mechanism at step 16. Step 18 identifies that the user has completed first level information input.

That is, the information is indicative of identity rather than indicative of whether the user is currently in compliance with one or more requirements of a registration authority. Additionally, the other cited references do not remedy the deficiencies of French. For example, although Aucsmith does teach that a driver's license may be validated, a driver's license is not a professional license. There is no motivation

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in the references to modify the teachings of Aucsmith to include the features of claim 1.

The method according to claim 1 may provide a number of benefits not found in the cited art. An important example is outlined in the current specification: the exchange of medical information and the performance of actions related to the practice of medicine. These actions (such as prescribing medicine or providing prescription medicines to patients) are governed by strict regulations. For example, many actions may be performed only by a licensed physician or at the direction of a licensed physician.

On the other hand, the ability to perform some actions with the assistance of modern technology may provide a substantial benefit. Patients may have easier access to needed medicines, and doctors (or other authorized medical professionals) may be able to access information or perform actions more quickly and efficiently.

However, the potential speed and efficiency gains need to be obtained without compromising the security of the medical system. Thus, the current inventors recognized that an authorization process that may be used to ensure that only persons in compliance with the requirements of the relevant

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registration authority are able to perform restricted actions and gain access to restricted information.

Since none of the cited references teaches or suggests that "the registration information includes information indicative of an identity of the user, and further includes a registration status of the user indicating whether the user is currently in compliance with one or more requirements of a professional registration authority," none of the cited references provide such a benefit.

For at least the above reason, claim 1 is patentable over the cited references, alone or in combination.

Each of the remaining claims includes similar features to those discussed above with respect to claim 1, and are therefore allowable for at least the reasons outlined above.

CONCLUSION

It is believed that all of the pending claims have been addressed in this paper. However, failure to address a specific rejection, issue, or comment, does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above are not intended to be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent

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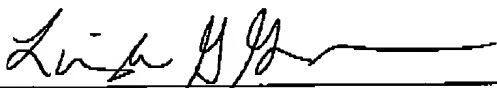
to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Claims 1-41 are in condition for allowance, and a notice to that effect is respectfully solicited. If the Examiner has any questions regarding this response, the Examiner is invited to telephone the undersigned at (858) 678-4311.

Please apply any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: 09/28/04


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Amendments to the Specification:

Please replace the Abstract with the following marked-up Abstract.

MANAGED AUTHENTICATION SERVICE

ABSTRACT

A managed authentication service ~~is described that~~ provides relying parties an out-sourced authentication service for verifying the identity of online visitors. The service provides real-time, managed authentication and usage monitoring, multiple identity confirmation levels and a highly scalable and secure solution for authenticating online transactions.